



Remarks

The Rejection of Claims 1-3, 6 and 10 Under 35 U.S.C. §102

The Office Action rejected Claims 1-3, 6 and 10 under 35 U.S.C. §102(b) as being anticipated by Rodriguez et al. (USPN 5,330,119). The specific basis for this rejection appears to be "Fig. 9".

Independent Claim 1 has been amended to indicate that the coil reel hold-down device is free-standing and includes a stand-alone means for effecting a pivoting movement of the snubber arm relative to the base plate. Support for these amendments can be found in paragraph [0008] and paragraph [0028]. Thus, no new matter has been added by the amendment.

35 U.S.C. §102(b) provides that "a person shall be entitled to a patent unless the invention was patented or described in a printed publication . . . more than one year prior to the date of the application." Accordingly, a rejection based on anticipation requires that the four corners of a single, prior art document describe each and every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. Ireco, Inc.*, 51 U.S.P.Q.2d 1943, 1947 (Fed. Cir. 1999). In other words, anticipation requires identity of invention: the claimed invention, as described in appropriately construed claims, must be the same as that of the reference, in order to anticipate. *Glaverbel Societe Anonyme v. Northlake Marketing & Supply Inc.*, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995). *See also In re Spada*, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"). Anticipation is a question of fact. *In re Graves*, 36 U.S.P.Q.2d 1697, 1700 (Fed. Cir. 1995). An invention is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. Neither the entire Rodriguez et al. reference nor specifically, Figure 9 of Rodriguez, either expressly or inherently, teaches a free-standing coil reel hold-down device which includes a stand-alone means for effecting a pivoting movement of the snubber arm relative to the base plate. Instead, since the Rodriguez apparatus was designed to simultaneously handle multiple coils, it features an integrated "at least two" coil support and holding means which must be necessarily components of a large, complex, expensive feeding apparatus which requires electrical power to function. Thus, the Rodriguez coil support and holding means cannot be used as a free-standing coil reel hold-down

device that can be adapted for existing coil reel feeding apparatus. As a part of a larger machine, the Rodriguez coil-reel component also cannot be operated independently or transported easily. Thus in light of the amendments, Applicant respectfully traverses the rejection of Claims 1-3 6 and 10, and requests reconsideration.

The Rejection of Claims 4-5, 7-9, and 11-12 Under 35 U.S.C. §103

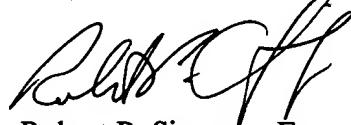
The Office Action rejected Claims 7-9, and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Rodriguez et al. (USPN 5,330,119). The Office Action also rejected Claims 4 and 5 as being unpatentable over Rodriguez et al. in view of Orii (USPN 4,589,605).

In light of the amendments to Claim 1, upon which Claims 4-5, 7-9 and 11-12 depend, Applicants request reconsideration of the rejections of these claims. Furthermore, Applicants note that Rodriguez and Orii are non-analogous art. These inventions relate to “specific use” hold-down devices that are an inseparable, integral component of more complex/expensive apparatuses, rather than the unique “stand-alone” and readily-adaptable apparatus of the instant invention. Also, deficiencies of cited references in teaching or suggesting all of the claim limitations cannot be remedied by general conclusions about what is “basic knowledge”, “common sense” or “desirable”. *In Re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002). Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention … when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id*; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Similarly, the non-analogous references should not be used in hindsight to infer that the coil-reel hold down device could be free-standing.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action. Applicants respectfully submit that the present application is now in condition for Issue, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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